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Remarks

Claims 29-48 were pending in this Application. Claim 39 has been amended. Thus claims 29-48 remain subject to continued examination.

Claim Objections

Claims 29 and 39 stand objected to for containing unclear language.

The Office Action takes the position that the phrase in claim 29 has language errors: "wherein said at least one portion of said treated substrate retains at least about 50% of said adhered to finish after 10 washes". Applicants apparently meant to communicate "wherein said at least one portion of said treated substrate retains at least about 50% of said adhered to finish after 10 washes". Applicants note that claim 29 was amended to include this change in the Replacement Brief on Appeal Under 37 CFR 1.192 transmitted via facsimile on June 10, 2004. This change was made pursuant to a telephone conference with the Examiner. In the event that such change has not been entered, Applicants request that the Examiner contact the agent of record so as to permit submission of a supplemental amendment.

The Office Action takes the position that claims 29 and 39 include the following error: "wherein if said metal is zinc then at least one hydrophilic binder compound at least one hydrophobic binder compound are present" apparently meant to communicate "wherein if said metal is zinc then at least one hydrophilic binder compound and at least one hydrophobic binder compound are present". Applicants note that claims 29 and 39 were amended to include this change in the Replacement Brief on Appeal Under 37 CFR 1.192 transmitted via facsimile on June 10, 2004. This change was made pursuant to a telephone conference with the Examiner. In the event that such change has not been entered, Applicants request that the Examiner contact the agent of record so as to permit submission of a supplemental amendment.

Anticipation Rejections

Claims 29-31, 33-41 and 43-48 stand rejected under 35 U.S.C. 102(a) as being anticipated by Yokozeki et al. (US 5,981,063). As regards claim 29 The Office Action takes the position that Yokozeki discloses the instant invention with the exception of "at least one

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portion of said treated substrate retains at least about 50% of said finish after 10 washes as performed in accordance with the wash procedure of MTCC Test Method 130-1981". The Examiner presumes that this limitation is inherent to the invention based on the use of similar materials.

As regards claim 39, the Office Action takes the position that Yokozeki discloses the claimed invention with the exception of a treated substrate "wherein said at least a portion of the surface of said treated substrate exhibits a) a log kill rate for *Staphylococcus aureus* of at least 1.5 and b) a log kill rate for *Klebsiella pneumoniae* of at least 1.5, both as tested in accordance with AATCC Test Method 100-1993 for 24 hour exposure, and c) retention of at least about 50% of said treatment, all after at least 10 washes, said washes performed in accordance with the wash procedure as part of AATCC Test Method 130-1981". The Examiner presumes that this limitation is also inherent to the invention based on the use of similar materials.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim (MPEP § 2131). Applicants respectfully submit that Yokozeki does not satisfy this rigorous standard.

As regards claim 29, Applicants respectfully submit that Yokozeki fails to disclose a treated substrate "wherein said at least one portion of said treated substrate retains at least about 50% of said finish after 10 washes as performed in accordance with the wash procedure of AATCC Test Method 130-1981; and wherein said treated substrate is electrically non-conductive".

As best understood, Yokozeki discloses a fiber product containing a pyroelectric substance and metal ion-holding inorganic particles wherein the pyroelectric property of the pyroelectric substance is amplified by the metal ion-holding inorganic particles (Abstract). The pyroelectric compounds may be incorporated into the manufacture of the fibers, or may be deposited on the fibers by using a binder (e.g. an adhesive resin) (Col. 3, lines 40-43). As best understood, pyroelectric substances are by definition electrically conductive. Pyroelectricity is the generation of an electric charge on certain crystals (such as tourmaline) as a result of a change in temperature. Thus, Yokozeki does not disclose a treated substrate which is electrically non-conductive. Accordingly, Applicants respectfully submit that the rejection of claim 29, and all claims depending directly or indirectly from claim 29 should not be maintained.

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Furthermore, the Office Action takes the position that the limitation "said at least one portion of said treated substrate retains at least about 50% of said finish after 10 washes as performed in accordance with the wash procedure of AATCC Test Method 130-1981" is inherent. MPEP § 2112 clearly states that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Applicants respectfully submit that there is no such evidence of record and therefore the rejection of the instant claims on the basis of inherency is not proper. Accordingly, the anticipation rejection of claim 29, and all claims depending directly or indirectly from claim 29, should not be maintained.

As regards claim 39, Applicants respectfully submit that Yokozeki fails to disclose a treated substrate comprising a non-electrically conductive treatment, wherein said at least a portion of the surface of said treated substrate exhibits a) a log kill rate for *Staphylococcus aureus* of at least 1.5 and b) a log kill rate for *Klebsiella pneumoniae* of at least 1.5, both as tested in accordance with AATCC Test Method 100-1993 for 24 hour exposure, and c) retention of at least about 50% of said treatment, all after at least 10 washes, said washes performed in accordance with the wash procedure as part of AATCC Test Method 130-1981.

Applicants rely on the arguments presented above as to the failure of the cited art to disclose Applicants' claim limitation that the treatment be non-electrically conductive. As to the Office Action position that a treated substrate "wherein said at least a portion of the surface of said treated substrate exhibits a) a log kill rate for *Staphylococcus aureus* of at least 1.5 and b) a log kill rate for *Klebsiella pneumoniae* of at least 1.5, both as tested in accordance with AATCC Test Method 100-1993 for 24 hour exposure, and c) retention of at least about 50% of said treatment, all after at least 10 washes, said washes performed in accordance with the wash procedure as part of AATCC Test Method 130-1981" is inherent, Applicants again rely on the arguments presented above. Applicants respectfully submit that there is no extrinsic evidence that would make clear that the missing descriptive matter is necessarily present in the fiber product described in Yokozeki, and therefore the rejection of claim 39 on the basis of inherency is not proper. In light of the above, Applicants respectfully submit that the anticipation rejection of claim 39, and all claims depending directly or indirectly from claim 39 should not be maintained.

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Obviousness Rejections

Claims 32 and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yokozeki et al. (US 5,981,063) in view of Sawan et al. (US 5,849,311). The Office Action takes the position that while Yokozeki teaches the use of fibers as a substrate, no disclosure is provided to teach the use of a film substrate and looks to Sawan to supply that teaching.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (MPEP § 2143.03). As presented above, Yokozeki fails to teach a non-electrically conductive treatment comprising the claimed wash durability and antimicrobial properties of independent claims 29 and 39. Applicants respectfully submit that the failure of the primary reference is not cured by the addition of Sawan and therefore a finding of obviousness is not proper for dependent claims 32 and 42.

Furthermore, MPEP § 2143.01 specifically states that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. As best understood, pyroelectric substances are excellent for ameliorating diseases and promoting health, as well as maintaining the freshness of foods etc. (Col. 1 lines 6-13). In order to provide textile goods that exhibit these beneficial properties, Yokozeki presents a process by which fibers are produced containing these pyroelectric substances. As best understood, this process requires the presence of metal ion-holding inorganic particles in order to amplify the pyroelectric properties of the resulting fiber article (Abstract). These pyroelectric properties are critical to Yokozeki's invention, and Applicants respectfully submit that to require that the treatment of Yokozeki be non-electrically conductive would in fact render it unsatisfactory for its intended purpose.

Applicants note that the cited art in its entirety must teach or suggest the invention as claimed. Accordingly, it would appear that this combination of references provides no teaching or suggestion to support a finding of *prima facie* obviousness. Thus, Applicants respectfully submit that the rejection of dependent claims 32 and 42 should not be maintained.

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Conclusion:

For the reasons set forth above, it is respectfully submitted that all claims now stand in condition for allowance.

Should any issues remain after consideration of this Amendment and accompanying Remarks, the Examiner is invited and encouraged to telephone the undersigned in the hope that any such issue may be promptly and satisfactorily resolved.

To any extent required for acceptance of this paper, an extension of time is hereby requested.

In the event that there are additional fees associated with the submission of these papers (including extension of time fees), authorization is hereby provided to withdraw such fees from Deposit Account No. 04-0500.

October 8, 2004

Respectfully submitted,

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